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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,499	04/14/2000	G. Victor Guyan	7752.0016-00	9245

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EXAMINER

VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 05/18/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/550,499

Applicant(s)

GUYAN ET AL.

Examiner

Gregory J. Vaughn

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the application amendment, application amendment filed on 2/24/2004.
2. Applicant has amended claims 1, 9 and 13.
3. Claims 1-21 are pending in the case, claims 1, 9 and 13 are independent claims.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

“(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.”

5. Claims 1-21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nolan et al., US Patent 5,253,362 (filed 1/29/1990, patented 10/12/1993) in view of Borghesi et al., US Patent 5,950,169 (filed 11/9/1995, patented 9/7/1999). “Nolan et al.” is hereafter referred to as “Nolan”. “Borghesi et al.” is hereafter referred to as “Borghesi”.
6. In regard to independent claim 1, Nolan recites: “In FIG. 4, a nursing annotation window 480 is illustrated. Window 480 provides a parameter title 481,

date 482, time 483" (column 5, lines 20-22). Nolan also recites: "Additionally, when an annotation is to be entered, such as in FIG. 6, a window 498 may be displayed. Window 498 provides a list of predefined, commonly used annotations" (column 5, lines 51-54). Nolan further recites: "Next, in decision step 203, if a standard option is selected from the standard annotation options, process 200 continues on to step 204. In step 204, the standard option selected is entered into the annotation field of the cell. If a standard option is not selected, step 203, or following step 204, the process allows entry of text into the annotation field, step 205" (column 6, lines 40-47). Also, Nolan recites: "If the "SHOW DETAIL" selection was made from window 470 of FIG. 3, following the entry of the nursing annotation, a window 486 would be displayed, FIG. 5. Show detail window 486 provides a parameter 487, date 488, time 489, systolic pressure 490, diastolic pressure 491, average pressure 492, date entered 493, time entered 494, entry by 495, and the nurse annotation 496" (column 5, lines 28-34).

Nolan discloses an annotation system with: the prefilling of data by the system, a user selecting additional fields for data entry, a user adding data to the predefined text area and the generation of an annotation containing the prefilled data, predefined text fields and the user text. Nolan fails to disclose the use of the annotation system with a suffix indicating a type of insurance coverage for insurance claims. Borghesi discloses an insurance claim processing system. Borghesi recites: *"The present invention provides for a comprehensive method and system for processing insurance claims for use by insurance companies" (column 2 lines 33-*

35). Regarding the amendment to claim 1, Borghesi recites: "*The policy information frame includes type of coverage*" column 9, lines 39-40).

Therefore, it would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to modify the annotations system described by Nolan to manage insurance claims because "*there is a need for a comprehensive system and method of managing an insurance claim work flow wherein all the tasks of processing a claim may be performed and evaluated*" (Borghesi, column 2, lines 20-23).

7. **In regard to dependent claim 2**, Nolan recites: "*This annotation will then be saved in the data base along with the other data for cell 465*" (column 5, lines 26-27).
8. **In regard to dependent claim 3**, Nolan recites: "*Window 498 provides a list of predefined, commonly used annotations*" (column 5, lines 53-54) and "*the process allows entry of text into the annotation field, step 205*" (column 6, lines 46-47).
9. **In regard to dependent claim 4**, Nolan recites: "*Window 480 provides a parameter title 481, date 482, time 483, and a place for the nursing annotation 484*" (column 5, lines 21-22).
10. **In regard to dependent claim 5**, the claim contains substantially the same subject matter as claims 1 and 2 combined, and remains rejected using the same rationale.

11. **In regard to dependent claim 6**, Nolan recites: "*assigning a first notational designator to said first annotation text*" (column 8, lines 16-17).
12. **In regard to dependent claim 7**, Nolan discloses a category field "*Blood Pressure*" and subcategory fields "*Systolic*" and "*Diastolic*" in Figure 5.
13. **In regard to dependent claim 8**, Nolan discloses a suffix field "Vitals" and a series of related fields ("*Heart Rate*", "*Blood Pressure*", "*Temp.*", and "*Respiration Rate*") that each represent a part of the suffix field in Figure 5.
14. **In regard to independent claim 9**, the claim contains substantially the same subject matter as claim 1, and remains rejected using the same rationale.
15. **In regard to dependent claim 10**, the claim contains substantially the same subject matter as claims 7 and 8 combined, and remains rejected using the same rationale.
16. **In regard to dependent claim 11**, the claim contains substantially the same subject matter as claim 8, and remains rejected using the same rationale.
17. **In regard to dependent claim 12**, the claim contains substantially the same subject matter as claim 4, and is rejected using the same rationale.
18. **In regard to independent claim 13**, the claim contains substantially the same subject matter as claim 1, and remains rejected using the same rationale.

19. **In regard to dependent claim 14**, the claim contains substantially the same subject matter as claim 2, and remains rejected using the same rationale.
20. **In regard to dependent claim 15**, the claim contains substantially the same subject matter as claim 3, and remains rejected using the same rationale.
21. **In regard to dependent claim 16**, the claim contains substantially the same subject matter as claim 4, and remains rejected using the same rationale.
22. **In regard to dependent claim 17**, the claim contains substantially the same subject matter as claim 5, and remains rejected using the same rationale.
23. **In regard to dependent claim 18**, the claim contains substantially the same subject matter as claim 6, and remains rejected using the same rationale.
24. **In regard to dependent claim 19**, the claim contains substantially the same subject matter as claim 7, and remains rejected using the same rationale.
25. **In regard to dependent claim 20**, the claim contains substantially the same subject matter as claim 8, and remains rejected using the same rationale.
26. **In regard to dependent claim 21**, the claim contains substantially the same subject matter as claim 1, and remains rejected using the same rationale.

Response to Arguments

27. Applicant's arguments filed 2/24/2004 have been fully considered but they are not persuasive.
28. **Regarding amended claims 1, 9 and 13**, the claims remain rejected under 35 USC 103(a) as described above.
29. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *"the suffix field of Applicant's invention is specific to a participant, and could vary between participants, and could change for a given participant depending upon the insurance coverage desired by the participant"* (page 5, last paragraph)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (703) 305-4672. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached at (703) 308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
May 13, 2004



STEPHEN S. HONG
PRIMARY EXAMINER